

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
10702700	10/02/00	ENTENMANN	M 12964.15

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EXAMINER	
FELTEN, D	
ART UNIT	PAPER NUMBER

2164

DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/678,295	Applicant(s) Entenmann
Examiner Daniel Felten	Art Unit 2164

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Oct 2, 2000
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 835 C.D. 11; 453 O.G. 213.
- Disposition of Claims
- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4, 6-8, and 18-20 is/are rejected.
- 7) Claim(s) 5, 9-17, 21, and 22 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 & 6
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

DETAILED ACTION

1

Claim Objections

2 1. Claims 5, 9-19, 21 and 22 are objected to under 37 CFR 1.75(c), as being of improper
3 dependent form for failing to further limit the subject matter of a previous claim. Applicant is
4 required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent
5 form, or rewrite the claim(s) in independent form. The phrase, "...according to *any* of the
6 preceding claim(s)" is not understood by the examiner because it is not recognized to which of
7 the preceding claim(s) the instant claim is referring to. Therefore the aforementioned claims
8 should not be treated on their merits.

10

Claim Rejections - 35 USC § 112

11 2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

12 The specification shall conclude with one or more claims particularly pointing out and
13 distinctly claiming the subject matter which the applicant regards as his invention.
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16 3. Claims 1 and 2 recites the limitation "it" in independent claim 1, line 3. There is
17 insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 103

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2 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
3 obviousness rejections set forth in this Office action:

4 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
5 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
6 such that the subject matter as a whole would have been obvious at the time the invention was made to a person
7 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
8 manner in which the invention was made.

9
10 5. Claims 1-4, 6-8, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable
11 over Hultergren (WO 98/47116) in view of Musa (US 6,016,349).

12
13 **Regarding method claims 1, 3, 6 and apparatus claims 18- 20:**
14 A method and/or apparatus of effecting a cashless payment transaction, by means of a merchant
15 station characterized by a merchant station identification code (*see 70 merchant terminal*, page 7,
16 ll. 5-9; also see *merchant's account*, page 8, ll. 13-16 or merchant identifier, page 9, ll. 2-4), a
17 mobile cell phone 60 and a comparing device 3, which comprises a transaction data memory
18 device (*see transaction record generator*- 206-1; page 11, ll. 5-11), a merchant checking device
19 transfer 206 (*see coordinate module*) for checking the identification codes of the merchant
20 stations authorized for this method, and a subscriber checking device (verification unit 204-3) for
21 checking the identification codes of the smart cards authorized for this method and which is
22 connected to account (*see pages 6-20*).

1 Hultergren discloses all the limitations of the invention, but fails to disclose a SMART

2 card characterized by an identification code identifying it.

3 Musa discloses a cellular phone which uses a smart card 5 (see fig. 1) that is characterized

4 by an identification code identifying it (see Musa col. 2, ll. 45-59). It would have been obvious

5 for an artisan of ordinary skill at the time of the invention to substitute the cellular phone in the

6 Hultergren invention with the phone in Musa because an artisan of ordinary skill at the time of

7 the invention would have considered the modification a substitution of art equivalence inasmuch

8 as both cellular phone in this aspect of the invention are relating to identification of the user.

9 Thus under normal engineering design practices, an artisan or ordinary skill in the art would

10 recognize the notoriously old and well known combination of a smart card and cell phone as a

11 cost effective means of user identification. Thus such a substitution would have been an obvious

12 design choice to one of ordinary skill in the art.

13

14 **As in claim 2:**

15 A method according to claim 1. characterized in that the merchant station (1) and the cell

16 phone (2) have interfaces (6) for wireless transmission of data from the merchant station to the

17 cell phone, and in that the identification code of the merchant station is transmitted to the mobile

18 cell phone through these interfaces for wireless transmission before the mobile phone connection

19 to the comparing device (3) is made, and in that the identification code stored there can be

1 transmitted during the existence of the connection to the comparing device (see Musa, col. 2 to
2 col. 4, ll. 51).

3

4 **As in claim 4:**

5 A method according to claim 3, characterized in that the mobile cell phone and the
6 merchant station comprise interfaces for wireless transmission of data and, at the beginning of
7 the method, the identification code associated with the smart card is transmitted from the mobile
8 cell phone through these interfaces to the merchant station and is there so stored that it can be
9 used in the following steps at the merchant station (see Musa, col. 2 to col. 4, ll. 51).

10

11 **As in claim 7:**

12 characterized in that as well as the merchant identification code, further data on the transaction is
13 transmitted in the first step (see Musa col. 2 to col. 4, ll. 51).

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15 **As in claim 8:**

16 characterized in that the identification code associated with the smart card is also transmitted in
17 the last step (see Musa col. 2 to col. 4, ll. 51).

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Conclusion

3 6. A list of cited references appears below not relied upon in this Office Action:

4 **US Patents:**

5 Wen (US 5,457,737) discloses methods and apparatus to verify the identity of cellular mobile
6 phone

7 Collett et al (US 5,711, 013) discloses conformant compact portable cellular phone case system
8 and connector

9 Hughes et al (US 5,754, 655) discloses a system for remote purchase payment and remote bill
10 payment

11 Mihm, Jr. et al (US 5,293,576) discloses a command authentication process

12 Simpson et al (US 5,404,580) discloses a radio having memory means for storing radio user
13 validation code

14 Flanders et al (US 5,239,294) discloses a method and apparatus for authentication and protection
15 of subscribers in telecommunication systems.

16 7. Any inquiry concerning this communication or earlier communications from the examiner
17 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The

18 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.

19 Any inquiry of a general nature relating to the status of this application or its proceedings should
20 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor

21 **Vincent Millin** whose telephone number is (703) 308-1065.

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25 8. Response to this action should be mailed to:

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2 Commissioner of Patents and Trademarks

3 Washington, D.C. 20231

4
5 for formal communications intended for entry, or (703) 305-0040, for informal or draft
6 communications, please label "Proposed" or "Draft".

7 Communications via Internet e-mail regarding this application, other than those under 35
8 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
9 addressed to [daniel.felten@uspto.gov].

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11
12
13 All Internet e-mail communications will be made of record in the application file. PTO
14 employees do not engage in Internet communications where there exists a possibility that
15 sensitive information could be identified or exchanged unless the record includes a properly
16 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
17 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
18 Trademark on February 25, 1997 at 1 195 OG 89.

19
20
21 

22 Daniel S. Felten
23 September 25, 2001


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
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